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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,045	09/13/2003	David J. Laverick	702.276	1970

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EXAMINER

DIACOU, ARI M

ART UNIT	PAPER NUMBER
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3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/663,045	Applicant(s) LAVERICK ET AL.	
	Examiner Ari M. Diacou	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12-20-2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In the remarks filed 12-20-2006, applicant argued the following:
 - A. On page 12-15, that the "New matter" rejections were improper because the amendments to the claims were enabled by the original disclosure.
 - B. On pages 15-21, that the 103 rejections were deficient for various reasons.
2. Argument A. is convincing the rejection is hereby withdrawn.
3. Argument B is moot in view of the new grounds of rejection.

Specification

4. The disclosure is objected to because of the following informalities:
 - On page 1, line 17, "____/_____" → "10/663,044".
 - On page 6, line 2, and page 24, line 19, "_____, filed _____." → "10/633,044, filed 9-12-2003".
 - On page 17, line 21, insert a carriage return after "9."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3663

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 23-27 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Mola et al. (USP No. 6125030).

- Regarding claim 1, Mola discloses a navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:
 - a portable navigational device; and [Fig. 1, #20]
 - a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device, wherein the navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly. [Fig. 1, #10]
- Regarding claim 24, Mola discloses a navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:
 - a stand-alone hand-held portable navigational device; and [Fig. 1, #20]
 - a mounting assembly for mounting on an existing support pillar of the vehicle and sized and configured to mate with the support pillar and removably receive the navigational device, such that the navigation device

Art Unit: 3663

remains visible and fully functional when received within the mounting assembly. [Fig. 1, #10]

- Regarding claims 2 and 25, Mola discloses [Col. 1, lines 10-26].
- Regarding claim 4 and 27, Mola discloses the navigation assembly as claimed in claim 24, wherein the mounting assembly includes:
 - a trim piece, [Fig. 1, #12]
 - a base secured to the trim, [Roof of car]
 - a docking station mounted within the base and designed to conform to the shape of the navigation device, and [Cavity in Fig. 1, #10]
 - a retractable faceplate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station. [Fig. 1, #22]
- Regarding claims 30, the claimed limitations are inherent to all GPS navigators.
- Regarding claims 3, 23 and 26, Mola discloses an overhead compartment, which is inherently above the windshield. [See Fig. 1 and the Title]

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3663

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5-7 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mola as applied to claims 1-4, 23-28 and 30 above, and further in view of Funk (USP No. 6681176).

- Regarding claims 5 and 29, Mola discloses the invention with all the limitations of claims 1-4 and 24, but fails to disclose electrical connections in the mounting mechanism for the handheld GPS device to provide charging for the battery, and data to the car. Funk teaches a handheld GPS device with a battery that gets

charged by the car, and data connections so that the user can input commands to the car (like volume adjustment) [Col. 4, line 66 - Col. 4, line 20]. Therefore, it would have been obvious to one skilled in the art (e.g. an electrical engineer) at the time the invention was made, to provide data and power connections to the GPS mounting assembly of Mola, by using the teachings of Funk, for the advantage of not using the battery of the handheld GPS.

- Regarding claim 6 and 28, Mola discloses the invention with all the limitations of claims 1-4 and 24, and while teaching that the handheld GPS device can be a "micronav" made by Magellan (to the best of the examiner's knowledge a "micronav" is not a Magellan model, but refers to a touch screen made by a certain company), which could include a speaker, Mola does not teach as much, nor is it inherent. Instead, Funk further teaches that the handheld GPS/faceplate can have an AM/FM/MP3 stereo circuitry enclosed, including a built-in speaker, headphones or ear bud [Col. 5, line 17-20]. Therefore, it would have been obvious to one skilled in the art (e.g. an electrical engineer) at the time the invention was made, to include a speaker in the docking station, for the advantage of using the speaking functionality of Funk's handheld GPS.
- Regarding claim 7, the claimed limitations are inherent to all GPS navigators.

Conclusion

Art Unit: 3663

11. While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

12. The references made herein are done so for the convenience of the applicant. They are in no way intended to be limiting. The prior art should be considered in its entirety.

13. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.

14. As to limitations which are considered to be inherent in a reference, note the case law of In re Ludtke, 169 U.S.P.Q. 563; In re Swinehart, 169 U.S.P.Q. 226; In re Fitzgerald, 205 U.S.P.Q. 594; In re Best et al, 195 U.S.P.Q. 430; and In re Brown, 173 U.S.P.Q. 685, 688.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3663

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMD 3/6/2007


JACK KEITH
SUPERVISORY PATENT EXAMINER